

Remarks

This paper is filed in response to the Office Action dated February 13, 2004. As this paper is filed on May 13, 2004, this paper is timely filed.

I. Status of Amendments

Claims 1-53 were pending prior to this amendment. By this amendment, applicant cancels claims 1-53 without prejudice to refile, and adds new claims 54 - 77. Thus, claims 54 - 77 are now pending.

Because applicant previously paid fees for 3 independent and 53 total claims, applicant's amendments require no additional fee.

II. Response to Office Action

A. General Comments

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.¹ For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

¹ This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘ _____ ’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

B. The February 13 Office Action

In the February 13 Office Action, claims 1-16 and 20-53 were rejected under 35 U.S.C. 103 as allegedly unpatentable over Vancura (U.S. Patent No. 6,413,160) in view of Walker (U.S. Patent No. 6,394,899), and claims 17-19 were rejected as allegedly unpatentable over Vanura in view of Walker further in view of Official Notice. As claims 1-53 have been cancelled, without prejudice to refile, these rejections are moot. However, given the reliance placed on Vancura and Walker, applicant has the following comments.

As to claim 54, the claim recites receiving a wager from a player, displaying an image representing a first game, and determining to initiate a bonus game. The claim further recites selecting a trivia question and a fixed set of answers associated with the trivia question for the bonus game, the trivia question and the fixed set of answers having a difficulty level selected according to a criterion, displaying an image representing the bonus game, receiving an answer selection from the player of one of the fixed set of answers, and determining an award based on the answer selection.

In the Office Action, columns 3-6 of Vancura are cited as disclosing that “the difficulty of at least one question is determined by a status in the bonus game.” Initially, applicant notes that when a reference is complex or shows or describes subject matter other than that claimed, the examiner is obligated to designate as nearly as practicable the particular part relied upon (37 CFR § 1.104(c)(2)). It is not immediately obvious to applicant which part of columns 3-6 is being relied on to support the above-mentioned statement. If the reference is to the process of removing incorrect answers over time (Col 6, ll 13-15), applicant notes this is not the selection of a question and fixed set of answers having a difficulty level based on a criterion. Instead, this would appear to be a question with a variable set of answers where the likelihood of success varies over time. Therefore, applicant submits Vancura does not discuss, teach or suggest this limitation.

Walker also discusses a trivia game where a question is presented for a timed period and may include random removal of answers (Col 4, ll 12-22). Similar to the above discussion of Vancura, Walker’s timed question does not disclose, teach or suggest selection of a question and fixed set of answers having a difficulty level based on a criterion. Consequently, Walker does not disclose, teach or suggest all the limitations of claim 54.

Assuming, for the sake of argument, that Vancura is combinable with Walker (a point which applicant does not concede), the combination of these references does not disclose, teach or suggest each and every limitation of claim 54. In particular, Vancura and Walker, when taken in combination, cannot disclose, teach or suggest the limitation of selecting a trivia question and a fixed set of answers having a difficulty level selected according to a criterion because neither Vancura nor Walker individually discusses, teaches or suggests the limitation. Therefore, claim 54 is allowable over Vancura, Walker or a combination thereof.

Given that claims 55-65 depend from claim 54 and that claim 54 is distinguishable from Vancura and Walker, so too are claims 55-65.

Independent claim 66 recites a gaming system comprising a display unit, a wager input device, a player input device, and at least one processing unit operably coupled to the display unit, the wager input device, the player input device and a memory, the at least one processing unit receiving a wager via the wager input device from a player, the at least one processing unit causing the display unit to display an image representing a first game, the at least one processing unit determining to initiate a bonus game, the at least one processing unit selecting a trivia question and a fixed set of answers associated with the trivia question for the bonus game, the trivia question and the fixed set of answers having a difficulty level selected according to a criterion, the at least one processing unit displaying an image representing the bonus game, the at least one processing unit receiving an answer selection from the player of one of the fixed set of answers via the player input device, and the at least one processing unit determining an award based on the answer selection.

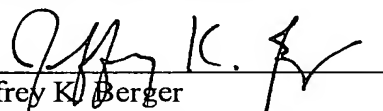
As discussed above relative to claim 54, neither Vancura nor Walker, whether taken individually or in combination, disclose, teach or suggest the limitation of selecting a trivia question and fixed set of answers having a difficulty level based on a criterion. Therefore, claim 66 is allowable and its dependent claims 67-77 are also allowable.

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In summary, in view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. Further, if there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855.

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Respectfully submitted,

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